

## **REMARKS**

### **Telephonic Interview**

On February 23, 2010, a telephonic interview was conducted between Marc S. Hanish, Reg. No. 42,626 and Examiner Theriault. The Examiner is kindly thanked for granting this interview. During the interview, a proposed amendment to the claims was discussed. The Examiner indicated that this proposed amendment, if added to the independent claims, would overcome the existing rejections, but the Examiner requested that an updated search be conducted. Applicant agreed. As to claim 67, a different proposed amendment was discussed, and the Examiner agreed to review the new text of claim 67 to determine whether the current rejection could be removed. Applicant agreed to submit the amendments formally for review by the Examiner. This paper represents the agreed-upon amendments.

### **Substantive Remarks**

Claims 49-54, 61-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Umemoto et al. (U.S. 6,983,251), in view of Hiipakka et al. (U.S. 2003/0098892), in further view of Forest et al. (U.S. 5,999,895).

Claims 65-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Umemoto et al. (U.S. 6,983,251), in view of Forest et al. (U.S. 5,999,895), in further view of LaChapelle et al. (U.S. 7,054,888).

As to claim 49, contrary to what is stated in the Office Action, Hiipakka fails to teach or suggest "receiving customization settings from a user, wherein the customization settings include an indication of a type of media file to navigate." Specifically, the Examiner points to paragraphs [0029] and [0048-0050] of Hiipakka as allegedly teaching this element. However, nothing in these sections, nor in any other part of Hiipakka, teaches customization settings including an indication of a type of media file to navigate.

The Examiner equates Hiipakka's profiles 502, 504, 506 with the customization settings. Hiipakka's profiles 502, 504, 506 allow the user to establish various preferences. Profile 502 allows the user to provide context values for auditory icons which indicate a ranking for the icons, so that the corresponding visual icons can be presented on a display in an order based on the ranking. Profile 504 allows the user to set how the icons are presented, such as whether to present them in increasing order, decreasing order, or limit the number to

a certain number of displayed icons. Profile 506 allows the user to set whether auditory icons should be presented in stereo or mono.

None of these preferences, however, discuss anything about an indication of a type of media file to navigate. They simply indicate an ordering or other visual factors on how the icons should be displayed, and then also whether ALL the auditory icons should be played in stereo or mono. As such, there is no teaching of customization settings including an indication of a type of media file to navigate.

Applicant also notes that the customization settings are not used to present different content for the audible output. Hiipakka refers to visual and auditory icons. The visual icons are displayed on the display, and the auditory icons are spoken word versions of those visual icons. However these icons have a 1:1 correspondence with each other. In other words, each visual icon has one and only one corresponding auditory icon. See paragraph [0025] (“Each visual icon and corresponding auditory icon pair represent a particular contextual message received by the mobile terminal”). Thus, the customization settings do not affect the content of the audible output, merely when and how the audible output is played. In other words, the actual audio file for a particular visual icon is always the same, regardless of what is in the profiles. The profile only changes when that audio output is played and how, but it does not allow the user to select from another, different audio output to make correspond to the visual icon.

Claim 49 has been amended to make this distinction more clear.

Furthermore, the Examiner cites Forest as teaching the providing of a “menu selection feature where the cursor can dwell on a menu option and after a period of time has expired the menu selection will occur,” The Examiner then argues that it would have been obvious to one of ordinary skill in the art to combine Forest with Umemoto and Hiipakka as they “all teach menu options are selectable and read aloud to the user and they all provide input mechanisms that help the user to make selections on the device.” Applicant respectfully disagrees.

The problem with the Examiner’s line of reasoning is that the Examiner is using Forest’s selection of a menu option to teach an aspect of an element of the claims that has nothing to do with the selection of a menu option, and yet also trying to use Forest’s selection of a menu option as the basis for combining the references. Applicant respectfully submits that the Examiner cannot have it both ways. Forest teaches actions taken during a selection step. The claimed invention has a selection step. The examiner’s stated motivation to combine Forest with other prior art references is because they all teach selection steps. It is

therefore improper for the Examiner to use the selection step in Forrest to teach some other step in the claimed invention.

Specifically, claim 49 of the present application has a step of (1) outputting an audible output for a menu item after a period of time has expired, and then has a **separate** step of (2) selecting the menu item. They are two distinct steps that have difference results. Forest only teaches aspects relating to step (2)

Specifically, Forest only teaches that a user can hover a cursor over a menu item, and then after a period of time has expired, the system will automatically select the menu item for the user, as if the user had clicked a mouse button or undertaken some other physical act that would ordinarily have selected the menu item. This allows a disabled user to select a menu item without actually having to depress a mouse button. It does not teach, however, anything at all about a separate step of audible outputs, or in fact performing **any** other step in response to the “hovering” of the cursor for a period of time. The only result of the hovering is the automatic selection of the menu option on behalf of the user, something that would ordinarily have resulted from a mouse click if the user had been able to do so.

Thus, Applicant does not believe it is proper to use the Forest reference to teach anything other than steps undertaken to automatically select a menu option for the user. In short, while it might have been proper to use the Forest reference to teach various elements of the step of (2) selecting the menu item in claim 49, it is improper to use that same aspect of Forest to teach elements of the step of (1) outputting an audible output. In addition to the selection element already being contained elsewhere in claim 49, there is also the fact that the outputting of an audible output for a menu option is fundamentally different that the selection of a menu item. The selection of a menu item is something that a mouse click would ordinarily generate, so Forest is essentially replacing a manual mouse click action with an automatic mouse click based on duration of hovering. That is different than the output of an audible output, something that would not ordinarily occur in response to a mouse click, or any other single movement. In short, there is no action to be replaced.

As such, Applicant respectfully maintains that the Forest reference is not relevant to the claimed invention.

For the above reasons, Applicant respectfully submits that claim 49 is in condition for allowance.

As to dependent claim 51, the Examiner argues that Umemoto teaches that the customized audible output corresponding to the particular navigation menu icon when a song file is the indicated type of the media file to navigate is a different audible output than would

be output for the particular navigation menu icon when a video file is the indicated type of media file to navigate, and points to column 13, lines 40-67 as evidence of this. This section of Umemoto states:

According to the example of FIG. 12, desired music information can be obtained by dividing the indexes into seven stages of S401, S402, S403, S405, S406 and S407 of the menu that can be selected. Also, by adding the message of "Return to one previous menu" in the index information of the seven stages, the information itself can be handled at a level identical to that of the system operation command.

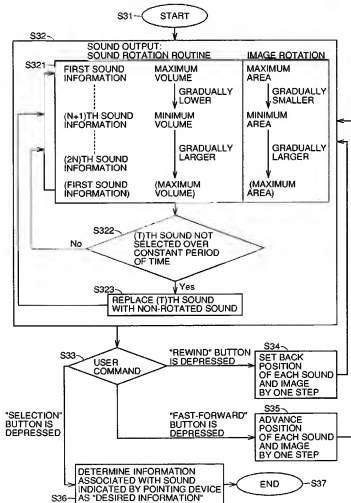
One or a plurality of the "Return to one previous menu" message can be prepared in a series of indexes. When there is a great number of indexes, this message can be prepared at a constant interval.

In the case where the present invention is applied to the program guidance of a multichannel broadcast, indexes such as for each genre, target age and the like can be prepared in addition to the indexes for each channel and time to facilitate the user's selection of a desired program. The index label may be presented in the form of a synthesized speech, or in the form of the exact audible output of the program.

When a list of the programs that is currently being broadcasted is to be presented according to the method of the present invention, presentation can be provided in a fashion switching the channel for every predetermined time. Alternatively, an audio output characteristic of respective programs can be presented as the program information. In this case where the program of a certain channel changes to another program of that same channel over time, the audio output of the new program is sequentially presented corresponding thereto.

Nothing in this section, nor anywhere else in Umemoto, teaches that an audible output for a particular navigation menu icon changes based upon whether the navigation involves song files versus video files. This cited section of Umemoto merely states that audio output can change when the "channel" changes. In other words, when the channel changes one song to another song, the audible output will change so that the audible output will be the one associated with the new song instead of the old song. However, this has nothing to do with a case of where the underlying menu option remains the same but the type of file being navigated changes. Additionally, Applicant notes that Umemoto does not describe navigating video files at all, let alone playing different audio outputs for the same menu item when navigating video files. As such, Applicant respectfully submits that claim 51 is in condition for allowance.

As to independent claim 52, Applicant respectfully disagrees with the contention in the Office Action that Umemoto teaches “providing a navigable hierarchical menu, wherein the hierarchical menu includes a hierarchical level including only navigation items, the navigation items corresponding to drill-down or drill-up commands to different levels of the hierarchical menu.” The Examiner points to FIG. 4 as evidence of this step, but FIG. 4 fails to either show or even discuss a hierarchical menu. FIG. 4 is as follows:



There are no hierarchies described here. Each sound is simply presented as a potential selection right away. There is no concept of levels, drilling down, or drilling up, which are necessary (and claimed) components of a hierarchy.

Furthermore, Applicant respectfully disagrees with the Examiner's contention that it would be obvious to modify Umemoto to eliminate a display. Umemoto contains various different and discrete embodiments, and the Examiner has relied upon the second embodiment of Umemoto and thus Applicant maintains it would be necessary to modify this embodiment of Umemoto to teach the claimed invention in order to reject claim 52. The Examiner cites column 3, lines 5-10 of Umemoto for the contention that audio output can be done without a display of visual icons. The second embodiment of Umemoto, however, is directed solely at the notion of introducing a visual image to aid in the information selection process (see col. 8, lines 59-62, "[a] second embodiment of the present invention will be described with reference to FIGS. 3 and 4. In the present second embodiment, an image is employed in addition to the sound for the purpose of information selection." Thus, even if the Examiner finds another embodiment of Umemoto where images do not need to be employed, modifying Umemoto's second embodiment to do so would be nonsensical because it would render the second embodiment unsuitable for its intended purpose.

Nevertheless, Applicant respectfully submits that the section of Umemoto that the Examiner cited for the contention that audio output can be done without a display of visual icons does not actually teach what the Examiner claims it teaches. Column 3, lines 5-10 state:

A further object of the present invention is to provide a sound information selection apparatus that can have the position change of a sound controlled by the user's intention.

Still another object of the present invention is to provide an information selection apparatus that allows selection of an information source without depending upon only visual recognition.

Here, contrary to the Examiner's position, Umemoto is not saying that the audio output can be done without a display of visual icons, but rather that audio output can be provided **along with** visual icons so that the user does not need to depend **only** upon visual icons to perform information selection.

Thus, Applicant respectfully submits that Umemoto does not teach what the Examiner is assuming it teaches, and thus the basis for the Examiner's rejection is incorrect.

Furthermore, Applicant respectfully maintains that it is inappropriate to combine Hiipakka with Umemoto because it would render Umemoto unsuitable for its intended purpose. A display is specifically taught in Umemoto in several different places and embodiments (see, e.g., reference numeral 8 of FIG. 3 and reference numeral 8, of FIG. 7). Additionally, as described above, the second embodiment of Umemoto specifically is designed to present visual icons to aid in information selection, and removal of a display would render that embodiment unsuitable for this purpose. In short, it is not obvious to combine a reference (Hiipakka) showing a display is not necessary with a reference (Umemoto) showing a display is both present and specifically relied upon to perform its function. One simply cannot excise the display from Umemoto, as the display is fundamentally necessary for its invention. As such, Applicant respectfully submits that claim 52 is in condition for allowance.

As to independent claims 61 and 65, the claims contain elements similar to that as described above with respect to claim 49. As such, Applicant respectfully submits that these claims are in condition for allowance for the same reasons as described above with respect to claim 49.

Claims 55-60, 67-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Umemoto et al. (U.S. 6,983,251), in view of Hiipakka et al. (U.S. 2003/0098892), in further view of Forest et al. (U.S. 5,999,895), in further view of Janik et al. (U.S. 2002/0013852).

As to independent claim 67, the claim contains elements similar to that as described above with respect to claim 49. As such, Applicant respectfully submits that this claim is in condition for allowance for the same reasons as described above with respect to claim 49. However, in addition to that, Applicant respectfully submits that, contrary to what is stated in the Office Action, Janik fails to teach or suggest “wherein the audio file includes an indication of a period of time.” The Examiner refers to paragraphs [0170] of Janik as allegedly teaching this element. However, paragraph [0170] merely describes that a time and date can be embedded into metadata of a file or stream. This is what is known in the art as a “time stamp”. It merely states what time and date the file was created, or last updated, or accessed. It is merely an indication of a particular point in time, and as such, is not a “period of time”.

Additionally, claim 67 indicates that the claimed “period of time” is then used to compare with the actual passage of time during which a navigation component has been navigated to but not selected. If the actual passage of time is longer than the stored period of

time, an action is taken. A timestamp is simply unusable for this purpose, and cannot be substituted for a period of time.

Nevertheless, Applicant agreed during the interview to amend this claim to make clear that the period of time was actually a dwell time corresponding to the audio file. As such, Applicant respectfully submits that claim 67, as amended, is in condition for allowance.

Dependent claims 50-51, 53-60, 62-64, 66, and 68-72 are also patentably distinct from the cited references for at least the same reasons as those recited above for the independent claim, upon which they ultimately depend. These dependent claims recite additional limitations that further distinguish these dependent claims from the cited references. For at least these reasons, claims 50-51, 53-60, 62-64, 66, and 68-72 are not anticipated or made obvious by the prior art outlined in the Office Action.

Applicant believes that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,  
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